

**REMARKS**

**STATUS**

Claims 1-16 remain in the application. Claims 1, 9 and 14 are currently amended and do not add any new matter.

**CLAIM REJECTIONS-35 U.S.C. §112**

Claims 1-8 and 14 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Accordingly, Applicants have amended claim 1 to more clearly define portions of the claim directed to customers' access to information and transmission of the prescription order.

The Examiner alleges on page 3 of the Office action that the "so" clause of claim 1 seems to contradict the alternative language set forth in the earlier part of the claim. The Applicants believe that this portion of claim 1 fully meets the requirements of 35 U.S.C. § 112 second paragraph, and respectfully traverse this rejection. The Applicants state that the system as recited in claim 1 provides the ability to have a prescription drug shipped from a shipping facility after a prescription order is transmitted to either a member pharmacy or the shipping facility. Thus, Applicants submit that no contradiction exists.

The Examiner indicated some confusion on page 3 of the Office action over whether "the customer is a physician/health care professional/pharmacist ordering on behalf of his patients or if the applicant intends to include patients and healthcare professionals." In each claim, the term "customer" is not limited in any way, and thus includes patients and healthcare professionals.

The Examiner also indicated on page 3 of the Office action that the use of "configured to" in claim 1 makes it unclear whether a particular function is actually carried out by the recited hardware. Applicants respectfully submit that use of the language "configured to" fully complies with the statutory requirements of 35 U.S.C. § 112 second paragraph, and the Applicants request the rejection be withdrawn. It is common practice for practitioners to use

“configured to” in describing a function to be performed in a system claim such as pending claim 1. There currently exists over 170,000 issued U.S. patents that include claims having the “configured to” language. Moreover, the United States Court of Appeals for the Federal Circuit has reviewed this language numerous times without objection.

For at least the reasons stated above, the applicants believe that claims 1-8 and 14 meet the requirements of 35 U.S.C. § 112 and that the rejections should be withdrawn.

The invention set forth by claims 1-9, 11-12, and 15-16 are alleged not to meet the requirements of 35 U.S.C. §102(e) as being anticipated by U.S. Patent. No. 5,954,640 to Szabo (hereinafter "Szabo"), claim 10 is alleged not to meet the requirements of 35 U.S.C. §103(a) as being unpatentable over Szabo in view of U.S. Patent. No. 5,845,255 to Mayaud, and claims 13 and 14 are alleged not to meet the requirements of 35 U.S.C. §103(a) as being unpatentable over Szabo in view of Official Notice. The applicants respectfully traverse the allegations and respond as follows.

#### **CLAIMS 1-16 MEET THE REQUIREMENTS OF SECTIONS 102(e) AND 103(a)**

The first issue of patentability raised by the Office action, and which the applicants must overcome, is whether each and every limitation of claims 1-9, 11-12, and 15-16 is found in Szabo. The second issue of patentability raised by the Office action concerns the combination of Szabo in view of Mayaud, and whether the combination renders unpatentable claim 10 under 35 U.S.C. §103(a), as well as the combination of Szabo in view of Official Notice, and whether that combination renders unpatentable claims 13 and 14 under 35 U.S.C. §103(a). The applicants submit that claims 1-16 meet the requirements of both 35 U.S.C. §102(e) and 35 U.S.C. §103(a), and therefore, claims 1-16 are allowable. Applicants address the rejections separately as to each independent claim and the claims that depend therefrom.

#### **§ 102 Rejection based on Szabo Claims 1-9, 11-12, and 15-16**

Independent claim 1 as amended is directed to a system for accessing pharmacy data and ordering prescriptions via a network that includes an application server that allows

customers to access information concerning drugs and personal information relevant to that specific customer, as well as enabling each of the customers to transmit a prescription order to at least one of a plurality of member pharmacies or one of one or more shipping facilities, so that at least one prescription drug associated with a prescription order is shipped from the one of the one or more shipping facilities.

Szabo generally discloses a system providing an optimization of nutritional supplements based on models that allow prediction of a change in health. The Szabo system is particularly focused on nutritional supplements of incompletely or equivocally known value. *Szabo, Col. 1, lines 51-62*. In general, the Szabo system appears to be a pure web-based application and makes no provisions for incorporating and interconnecting a plurality of member pharmacies into its system.

It is thus respectfully submitted that Szabo does not disclose an intranet server that is connected to at least a plurality of member pharmacies and one or more shipping facilities, nor does it disclose an application server that is configured to allow customers to transmit a prescription order to at least one of the plurality of member pharmacies or one of the one or more shipping facilities, so that at least one prescription drug associated with the prescription order is shipped from the one of the one or more shipping facilities.

While the paragraph in Szabo identified by the Examiner discloses "a link to an on-line ordering system from a nutritional supplement supplier", the identified paragraph, as well as the whole of Szabo, does not disclose an intranet server that is connected to even one shipping facility. *Id., at Col. 10, lines 51-62*.

It is also submitted that Szabo does not disclose an application server that is configured to allow a customer to transmit a prescription order to at least one of the plurality of member pharmacies or one of the one or more shipping facilities, so that at least one prescription drug associated with the prescription order is shipped from a shipping facility. While Szabo discloses "an ordering system" in Col. 10, lines 59-60, nowhere does Szabo disclose allowing a customer to transmit a prescription order to either a pharmacy or a shipping facility.<sup>1</sup> And in particular, Szabo does not disclose enabling a customer to transmit

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<sup>1</sup> The Office action did not point out in particular where Szabo discloses transmitting a prescription order to one of the one or more shipping facilities. If the Examiner disagrees with Applicants' statements of what Szabo does not disclose, she is respectfully invited to point out where such disclosure exists in Szabo.

a prescription order so that at least one prescription drug associated with the prescription order is shipped from a shipping facility. This is because it was the inventors of the present invention that were the first to devise a system and appreciate the benefits of providing customers the convenience of placing a prescription order and having the order sent directly to their home, or any other convenient location, without ever having to leave their home or office.

Because no embodiment of Szabo appears to disclose the invention recited in amended claim 1, it is submitted that amended claim 1 is not anticipated by Szabo<sup>2</sup>. In order for a claim to be anticipated under §102, the anticipating reference must disclose at least one embodiment that incorporates all of the claimed elements. *See for example, C.R. Bard, Inc. v. M3 Systems*, 48 U.S.P.Q.2d 1225, 1230 (Fed. Cir. 1998) ("When the defense of lack of novelty is based on a printed publication that is asserted to describe the same invention, a finding of anticipation requires that the publication describe all of the elements of the claims, arranged as in the patented device..."); *In re Bond*, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990) ("For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference...These elements must be arranged as in the claim under review...").

Therefore, the invention recited in independent claim 1 is not anticipated by Szabo. It is respectfully submitted that claim 1 and claims 2-8 which depend therefrom are allowable over Szabo.

#### **Claims 9-16**

It is respectfully submitted that Szabo does not disclose a method of enabling one or more customers to order prescriptions and access pharmacy data via a network that includes displaying to a customer on a website at least one of a prescription order selection or a pharmacy data access selection. The method also includes displaying one or more prescription order displays to the customer on the website when the customer selects the prescription order selection wherein the customer is allowed to transmit a particular

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<sup>2</sup> If the Examiner believes there is an embodiment in Szabo that incorporates all of the recitations of one of the claims, she is respectfully invited to point it out and explain how it includes all the recitations of the claim.

prescription order to a communication network that connects at least one of a plurality of member pharmacies and one or more distribution facilities, and displaying one or more pharmacy data access displays to the customer when the customer selects the pharmacy data access selection wherein the customer is allowed to access one of a personal prescription history and specific drug information from a database.

As noted in connection with claim 1, there does not appear to be any disclosure in Szabo of (1) enabling one or more customers to order prescriptions and access pharmacy data via a network, (2) displaying to a customer one of a prescription order selection or a pharmacy data access selection, (3) displaying one or more prescription order displays to the customer on a website when the customer selects the prescription order selection wherein the customer is allowed to transmit a particular prescription order to a communication network that connects at least one of a plurality of member pharmacies and one or more distribution facilities; and (4) displaying one or more pharmacy data access displays to the customer when the customer selects the pharmacy data access selection wherein the customer is allowed to access one of a personal prescription history and specific drug information from a database.

Accordingly, it is submitted that claim 9, and claims 10 - 16 which depend therefrom, are not anticipated by Szabo. Moreover, it is submitted that the combination of Szabo with Mayaud and Official Notice does not render claims 10 and 13-14 obvious, as there is no disclosure in any of the cited references that provides motivation to combine them. Likewise, even if the combinations were made, the result would still not be the invention recited in claims 10 and 13-14.

### **CONCLUSION**

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue. If there is any matter that the Examiner would like to discuss, the Examiner is invited to contact the undersigned representative at the telephone number set forth below.

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Respectfully submitted,

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